

Application No. 10/711,246
Technology Center 1734
Amendment dated December 14, 2006
Reply to Office Action dated September 14, 2006

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REMARKS

In the Office Action, the Examiner reviewed claims 1-31 of the above-identified US Patent Application, with the result that claim 31 was withdrawn from consideration due to a restriction requirement, independent claim 1 and its dependent claims 3-8 and 17-30 were rejected under 35 USC §103 in view of U.S. Patent No. 3,463,694 to De Roshia, and claims 2 and 9-16 (which depend from claim 1) were deemed to recite allowable subject matter.

In the present response, Applicant has amended the claims as set forth above. More particularly:

All of the claims have been amended to be directed to a "tape dispenser system for applying an adhesive tape to a surface," as opposed to simply a "dispenser." Support for this amendment can be found in Applicant's specification at paragraphs [Para 16] ("a tape dispenser system").

Independent claim 1 has been further amended to recite the lateral guides (36) as elements of a "means for guiding the frame and inhibiting wobbling of the frame when traveling on the surface and applying the tape to the surface," and that the "lateral guides [are] independently pivotably attached . . . so that a portion thereof is pivotable to positions below the lower edge of its respective spaced-apart member independently of the other of the lateral guides such that either or both of the lateral guides can be selectively pivoted to

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the positions below the lower edges of their respective spaced-apart members to thereby define means for sliding against at least one lateral side of the surface.” Support for this amendment can be found in Applicant's specification at paragraph [Para 18] (“the dispenser 10 (and therefore the tape 14 applied by the dispenser 10) . . . accurately follow[s] one or both lateral sides 28 of the boards 24”; “[t]he inside faces of the guides 36 slide against the sides of the boards 24, preventing the dispenser 10 from wobbling as it travels the lengths of the boards 24”; “[b]ecause the guides 36 are independently adjustable, either guide 36 can be raised and lowered”).

Dependent claim 9 has been rewritten in independent form by incorporating all of the limitations of original independent claim 1.

Dependent claims 13, 18, 22, and 26 have been amended to require that the “the symbols and the numerical information of the tape comprise means for locating positions” (as opposed to merely “locate positions”) so that the functions of the symbols and numerical information is now more definitely recited as functional limitations of these claims. MPEP §2181.

Dependent claims 18, 22, and 26 have also been amended to depend directly from claim 1, instead of claim 17.

Dependent claim 27 has been amended to correct a typographical error.

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Finally, claim 31 has been canceled in view of the restriction requirement.

Applicant believes that the above amendments do not present new matter. Favorable reconsideration and allowance of claims 1-30 are respectfully requested in view of the above amendments and the following remarks.

In the explanation for the rejection of independent claim 1 and its dependent claims 3-8 and 17-30 under 35 USC §103, De Roshia was cited as disclosing "lateral guides, 108, pivotably attached to the spaced-apart members each of the guides being attached so that a portion thereof is pivotable to a position below the lower edge of its respective spaced apart member." As now amended, independent claim 1 clarifies that Applicant's lateral guides 36 are pivotable independent of each other, which is contrary to De Roshia's blade arms 108. Though De Roshia states the blade arms 108 are "individually pivotally mounted centrally thereof on the mounting assembly 21," the arms 108 are in fact coupled by the mounting assembly 21 and the cutting blade 115, which is attached to both blade arms 108 so as to be parallel to the roller 34, so that the blade arms 108 must rotate together and cannot rotate independently of each other. Any attempt to modify this construction to

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something similar to the structure claimed by Applicant would entirely destroy the intended function of De Roshia's blade arms 108 and cutting blade 115, which is to maintain the blade 115 parallel to the roller 34 so that the cutting blade 115 is able to cut the tape 80. See De Roshia at column 4, lines 58-70, and column 6, lines 16-33.

In view of the above, Applicant believes that independent claim 1 and all of its dependent claims 2-8 and 17-30 are allowable over De Roshia.

The Examiner cited dependent claim 9 as reciting allowable subject matter, specifically, "[n]one of the prior art suggests adding means for slitting the tape lengthwise as the tape travels from the forward end to the rearward end of the frame." As this limitation is independent of the limitations recited in claim 8, the intervening claim through which claim 9 originally depended from claim 1, claim 9 was rewritten as an independent claim by incorporating only the limitations of claim 1.

In view of the above, Applicant believes that independent claim 9 and its dependent claims 10-16 are also allowable over De Roshia.

With specific reference to dependent claims 6 and 18-30, the Examiner stated

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Regarding claims 6 and 18-30, limitations directed to the tape are only limitations of materials worked upon by the apparatus and are therefore not given patentable weight in an apparatus claim. Limitations to materials worked upon would be given patentable weight in "system" claims wherein the system positively recites both the apparatus and the material worked upon, in this case the dispenser and the adhesive tape, respectively.

In response, Applicant has amended the claims to be directed to a "tape dispenser system," as opposed to a "dispenser." In doing so, Applicant believes that the scope of the claims have not actually been altered at all, because the tape was already unequivocally recited as an element of the "dispenser" as originally claimed. In any event, the basis for disregarding the limitations of claims 6 and 18-30 is now believed to be moot as a result of amended independent claim 1 now being directed to a "system," as the Examiner helpfully suggested. Because De Roshia is merely directed to applying a masking tape, and does not disclose or suggest the presence of any "symbols and numerical information along a length thereof" as required by Applicant's claims, Applicant believes claims 6 and 18-30 are patentable over De Roshia.

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Closing

In view of the above, Applicant believes that the rejection of his claims has been overcome, and that the claims define patentable novelty over all the references, alone or in combination, of record. It is therefore respectfully requested that this patent application be given favorable reconsideration.

Should the Examiner have any questions with respect to any matter now of record, Applicant's representative may be reached at (219) 462-4999.

Respectfully submitted,

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December 14, 2006
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